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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,560	10/31/2003	Thomas Grafenauer	03100132US	8411
7055 7590 01/04/2007 GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT 1774	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE		DELIVERY MODE
3 MONTHS		01/04/2007		ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/04/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
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Office Action Summary

Application No.

10/697,560

Applicant(s)

GRAFENAUER, THOMAS

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-15 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some. * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10-12-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment filed October 12, 2006.

Claims 1-9 and 11-22 are pending, with claims 11-15 and 22 withdrawn as a non-elected invention.

RESPONSE TO REQUEST FOR RECONSIDERATION

2. Applicant's election with traverse of process for producing a panel (claim 22) is acknowledged. The traversal is on the ground(s) that it is improper to withdraw a linking claim from consideration and claim 22 should be examined on the merits. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product may be made by a materially different process, such as a process without heat. While it is noted that certain claims are product-by-process and incorporate the same process steps as described in Group II, a product defined by the process by which it can be made is still a product claim (*In re Bridgeford*, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process such as the alternative process described above (*In re Brown*, 173 USPQ 685, *In re Fessman*, 180 USPQ 324).

Claim Rejections – 35 USC § 103(a)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-5, 7-9 and 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luck et al. (U.S. 4,283,450).

Luck discloses a panel having a core and high density skins having a density of about 40-55 lbs/ft³ (column 1, lines 11-21) having a dense skin layers (termination layers) on the exterior surfaces of the core layer (column 3, lines 35-45 and column 4, lines 13-15). The top skin surface is hot pressed (stamped) and embossed and can be coated with paint (decoration) (column 4, lines 18-22, 30-34) where it would have been obvious to one of ordinary skill in the art for the density of the top skin to be lower than the density of the lower skin layer due to the top skin layer being embossed and having some of the material removed in the embossing process. The skin layers are comprised of resin binders and urea formaldehyde (column 9, lines 44-52). Because the core layer is less dense than the skin layers, it is expected for the density of the panel to continuously decrease from the top side to a substantial midpoint (core) and continuously decrease from the underside to the substantial midpoint (core), which would be substantially parabolic in shape. Luck does not explicitly shows that the panel has a density, gluing factor or density distribution as claimed. However, such features are properties which can be easily determined by one of ordinary skill in the art. With regard to the limitations of the density, gluing factor or density distribution, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. density, gluing factor or density distribution) fails to render claims patentable in the absence of

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unexpected results. All of the aforementioned limitations are optimizable as they directly affect the durability of the panel. It would have been obvious to one of ordinary skill in the art to make the panel with the limitations of the density, gluing factor or density distribution since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

Response to Arguments

5. Rejection made under 35 U.S.C. 112, first paragraph, is withdrawn due to Applicant providing support for the claims in pages 5 and 6 of the specification and in Figure 2.

Applicant's remarks to the rejection made under 35 USC 103(a) as being unpatentable over Luck et al. (U.S. 4,283,450) has been considered but is unpersuasive. Applicant argues Luck does not disclose the termination layer of the top skin having a structured surface. The top skin surface of Luck is hot pressed (stamped) and embossed (column 4, lines 18-22, 30-34) which renders the top skin surface having a structured surface. Applicant further argues Luck does not teach the density of the top side of the support is lower than the density of the support board on the underside. It would have been obvious to one of ordinary skill in the art for the density of the top skin to be lower than the density of the lower skin layer due to the top skin layer being embossed and having some of the material removed in the embossing process. Applicant argues Luck makes no suggestion that the density of one skin is different from the density of the other. The top skin surface of Luck is hot pressed (stamped) and

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embossed (column 4, lines 18-22, 30-34) where the underside skin is not hot pressed or embossed. Applicant argues the reference does not teach the density, gluing factor or density distribution of the panel are not merely the result of routine experimentation. Applicant has presented no showing that Luck cannot show these claimed features.

The rejection made under 35 USC 103(a) as being unpatentable over Luck et al. (U.S. 4,283,450) is withdrawn due to the reference not disclosing the gluing factor of less than 20% for isocyanates.

6. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not teach or suggest the recited panel further including a gluing factor of less than 20% for isocyanates. The prior art does not teach motivation or suggestion for modification to make the invention as instantly claimed.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



JENNIFER MCNEIL
SUPERVISORY PATENT EXAMINER

12/26/06